

Remarks

With the present amendment, claims 2-10, 12, 14-16, and 21 have been canceled without prejudice or disclaimer, and claim 17 has been amended. Applicants hereby reserve the right to pursue the subject matter encompassed by the cancelled claims in future divisional or continuation applications. Claims 24-65 (encompassing the polypeptides encoded by the invention corresponding to Gene No. 25) have been added to assist in expediting prosecution of the present application and to expand the embodiments of the elected subject matter. Hence, claims 1, 11, 13, 17-20 and 22-65 are currently pending in the present application.

The title of the application was amended to reflect the election of the invention corresponding to Gene No. 25 (clone HTEEB42).

Support for new claims 24-65 can be found throughout the application and claims as originally filed. More particularly, support for new claims 24, and 30 can be found at, for instance, Table 1, page 60, row 6, page 62, lines 19-29, page 63, lines 18-29, and page 65, line 15 to page 66, line 30. Support for new claims 25, and 31 can be found, for instance, in Table 1, page 60, row 6, and page 128, lines 1-8. Support for new claims 26, and 32 can be found, for instance, in Table 1, page 60, row 6, page 62, lines 19-29, and page 63, lines 18-29. Support for new claims 27, 33, 38, 43, 48, 53, 58, and 63 can be found, for instance, at page 64, lines 19-24, and page 124, line 4 to page 125, line 30. Support for new claims 28, 34, 39, 44, 49, 54, 59, and 64 can be found, for instance, at page 115, line 1 to page 118, line 31, and Example 23, pages 304-329. Support for new claims 29, 35, 40, 45, 50, 55, 60, and 65 can be found, for instance, at page 126, line 1 to page 138, line 5, Example 5, pages 271-273, and Examples 7-8, pages 274-279. Support for new claims 36-37, and 41-42 can be found, for instance, at page 67, line 1 to page 75, line 3. Support for new claims 46-47, 51-52, 56-57, and 61-62 can be found, for instance, at page 75, line 5 to page 78, line 23. Hence, no new matter has been added by way of this amendment.

Provisional Election With Traverse

The Examiner has required restriction of the claimed subject matter into one of ten different groups.

In order to be fully responsive, Applicants hereby provisionally elect, with traverse, the subject matter of Group II. (Additionally, Applicants herewith submit an amendment adding new claims 24-65 particularly related to Gene No. 25 and also drawn to the subject matter encompassed by Group II.) Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final. In such case, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement. Applicants note that the M.P.E.P. indicates, “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803. Assuming *arguendo*, that the groups listed by the Examiner represent distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of each group would entail a “serious burden.” M.P.E.P. § 803. In the present situation, no such showing has been made. Moreover, Applicants submit that a search of the polynucleotides of Group I (as they relate to Gene No. 25) would provide the corresponding amino acid sequences of Group II (as they relate to Gene No. 25). *See*, for instance, Palmeri *et al.* (2000), reference E (Fig. 1, page 19141) of the attached Information Disclosure Form PTO/SB/08. Similarly, a search of the polypeptides of Group II (as they relate to Gene No. 25) would provide the means to diagnose and/or treat the pathological conditions of Groups V (as they relate to Gene No. 25), and VII (as they relate to Gene No. 25), and help identifying the binding partners of Group VIII (as they relate to Gene No. 25). Hence, Applicants respectfully submit that a search encompassing the subject matter of Groups I-X (as they relate to Gene No. 25) would not impose a serious burden. Accordingly, Applicants respectfully request the restriction requirement be withdrawn.

Furthermore, if the restriction requirement is maintained, Applicants request rejoinder of the claims of Groups II, V and VII once the claims of Group II are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of

product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Id. Accordingly, if claims of Group II are found allowable, Applicants respectfully request that the claims of Groups V and VII (as they relate to Gene No. 25) be rejoined and examined for patentability. *See* also M.P.E.P. § 821.04.


Conclusion

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

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